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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,100	12/20/1999	HENRY WHITFIELD	ADEX0001	8312

22862 7590 12/02/2003

GLENN PATENT GROUP  
3475 EDISON WAY, SUITE L  
MENLO PARK, CA 94025

EXAMINER
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ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/472,100

Applicant(s)

WHITFIELD, HENRY

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
  - Claims 1-3, 6-8, 10-17, 21-23, and 26-30 are amended.
  - Claims 1-30 have been considered.
3. Examiner withdraws rejection of claims 1-30 under 35 U.S.C. 112-second paragraphs due to corrections by the applicant.

### ***Response to Amendment***

4. Applicant's arguments filed 15 September 2003 with respect to claims 1 and 16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent Publication No. US 2002/0062286 to Daniel E. Tedesco in view of U.S. Patent No. 6,193,155 to Jay S. Walker.

7. As per claims 1, 6, 9, 15, 16, 21, 24 and 30:

Tedesco et al teach a method and apparatus for processing checks such that Applicant's certificate authority reads on the bank device (pre-paid bank certificate), element 12, figures 1 and 2, Applicant's certificate issuance module reads on element 14 wherein Applicant's issued certificate reads on the reserved check, Applicant's public key identifier reads on the account identifier, Applicants' redemption denomination reads on the amount of funds reserved for the check, Applicant's private key

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reads on the reservation code, Applicant's certificate authentication module reads on element 16 wherein Applicant's authorization reads on the payee, element 16, providing to the bank, element 12 an account identifier, the redemption denomination (requested amount/amount of check); see paragraph [0060], starting at line 11, and the reservation code; see paragraph [0051], particularly the last sentence, and Applicant's means to cancel reads on the bank indicating that the check has been paid/claimed, paragraph [0064].

Although Tedesco mentions that goods are attained by using the pre-funded check [0067], but Tedesco is not specific on the relationship. However Walk clearly discloses the pre-funded certificate is used to pay for goods and/or services (See Walker column 5, lines 25-38 and column 9, lines 24-29). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention, if not inherent to use the pre-paid bank certificate (Check) of Tedesco, to allow the pre-paid certificate of Tedesco to be pay for goods and/or services that is obtained, this would make the certificate more widely acceptable or by the virtue of connecting such certificate with a particular merchant more specific (See Walker column 1, lines 56-65 and column 2, lines 7-11).

8. As per claims 2 and 17:

Applicant's second public key identifier reads on the check identifier, paragraph [0051]. The bank stores records of the reserved checks including the check identifier, paragraph [0039].

9. As per claims 3, 4, 18 and 19:

Applicant's payment agent reads on the financial account, paragraph [0047], from which the user wishes to use for payment of the reserved check. See also/instead paragraph [0075] wherein a user credit card can be used to charge a fee for the reserved check.

10. As per claims 5 and 20:

Applicant's authorization to transfer funds is considered inherent to the system of Tedesco et al, paragraphs [0047] and [0082].

11. As per claims 7, 8, 22 and 23:

Applicant's means to deliver reads on the inherent printed check as hinted at throughout the disclosure of Tedesco et al; see the "abstract" and paragraphs [0020, 0061 and 0063].

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12. As per claims 10 – 14 and 25 - 29

Although Tedesco et al do not specifically teach that the check is transferable to another user prior to redemption, Walker et al teach a system for issuing and managing gift certificates (the certificates are considered to be used and handled similarly to the checks of Tedesco et al), such that Walker et al disclose that a security code, selectable either by the certificate issuer (bank of Tedesco et al) or the user/purchaser of the certificate, is necessary for the redemption of a gift certificate as is required in Tedesco et al. Further, Walker et al discloses that the certificate is transferable to another user, other than the purchaser. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention, if not inherent to the teachings of Tedesco et al, to allow the check of Tedesco et al to be transferred to another (as well as the reservation code) prior to redemption as is taught by Walker et al, as transferring of either checks or gift certificates is considered to be a common occurrence with either checks or gift certificates; see also, Walker et al "Description of the Related Art".

13. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### **Conclusion**

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing

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date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

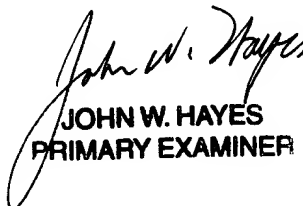
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive  
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K  
November 26, 2003**

  
**JOHN W. HAYES  
PRIMARY EXAMINER**